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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/174,804 10/19/98 MORROW

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EXAMINER

QM12/0205

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CHAMBERS, M

ART UNIT

PAPER NUMBER

3711

DATE MAILED:

02/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/174,804

Applicant(s)

Morrow et al

Examiner

M. Chambers

Group Art Unit

3711



☒ Responsive to communication(s) filed on Oct 23, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-81 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 1-57 is/are allowed.

☒ Claim(s) 58-62, 68, 69, and 75-81 is/are rejected.

☒ Claim(s) 63-67 and 70-74 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 21

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

This Office Action is a response to the Application filed on:

Number	Name	Date	Claims	Independent Claims
09174804	Morrow et al	10/19/98	74	5

**DETAILED ACTION**

***Priority***

1. This application claims priority as a CIP application of Design Patent D376,183 which was filed on May 3, 1995.
2. The applicant's representative has noted in a phone conversation that the meeting minutes submitted in the 1449 document were not considered relevant in a previous re-examination and requested clarification if they are considered relevant in the re-issue proceedings with regards to this apparent change in the examination standard.

The examiner has checked with the SPRE for group 3700 for clarification. In the initial examination process and subsequent reissue process, the examiner is permitted to draw on all available information to determine if a patent should be issued. This information can consist of patents, published documents, meeting minutes, declarations, and judicial notice. And based on these documents, the examiner will issue or reject a patent application. If the applicant objects to the decision, they can appeal to the board of appeals or the federal court. If the examiner's decision is overturned, the patent is issued.

Once the patent is issued, the standard for rejecting an issued patent is changed. According to the SPRE on a re-examine only patents and published documents are permitted to be used in the re-examination process. Meeting minutes are not considered published documents and therefore would not be considered relevant in the reexamination process.

Although the examiner understands that to the applicant, this may seem like an arbitrary decision but it is not. It is similar in nature to the standards used in the courts. During the trial both sides

have wide latitude to bring information to the court's attention. Once the trial court has issued a ruling, the bar changes. The appeals court is limited in what it can and cannot review. It is not permitted to insert new information but must use the information from the trial record. The re-examination process follows the same logic. There is a higher standard used. Only patents and published documents are considered relevant and meeting minutes are not considered published documents. If you require further clarification, please contact the SPRE directly-- Steve Marcus- (703)308-3872

### *Specification*

#### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 58-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tucker in view of Minutes and Cornelio. Tucker discloses the elements in claim 58. However Tucker fails to disclose the use of an offset head and the curving of the head downward. The Minutes disclose the offset head (item 3). It would have been obvious to one of ordinary skill at the time of the invention to have employed the offset of Minutes with the head of Tucker in order to give the player better control of the ball. However Minutes does not clearly disclose the way the offset is accomplished. Cornelio discloses a downward curving of the head (fig 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed the curving of Cornelio with the apparatus of Tucker and Minutes in order to give the apparatus an

artistic appearance.

As to claim 59: Cornelio discloses a downward curving of the head (fig 2).

As to claim 60, 61: Cornelio discloses curving back toward said plane at a substantially constant radius (fig 2).

As to claim 62: Tucker discloses sidewalls of uniform thickness (fig 1).

Claims 68-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tucker in view of Minutes and Cornelio. Tucker discloses the elements in claim 68. However Tucker fails to disclose the use of an offset head and the curving of the head downward. The Minutes disclose the offset head (item 3). It would have been obvious to one of ordinary skill at the time of the invention to have employed the offset of Minutes with the head of Tucker in order to give the player better control of the ball. However Minutes does not clearly disclose the way the offset is accomplished. Cornelio discloses a downward curving of the head (fig 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed the curving of Cornelio with the apparatus of Tucker and Minutes in order to give the apparatus an artistic appearance.

As to claim 69: Tucker discloses sidewalls of uniform thickness (fig 1).

Claims 75-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tucker in view of Minutes and Cornelio. Tucker discloses the elements in claim 75. However Tucker fails to disclose the use of an offset head and the curving of the head downward. The Minutes disclose the offset head (item 3). It would have been obvious to one of ordinary skill at the time of the invention to have employed the offset of Minutes with the head of Tucker in order to give the player better control of the ball. However Minutes does not clearly disclose the way the offset is

accomplished. Cornelio discloses a downward curving of the head (fig 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed the curving of Cornelio with the apparatus of Tucker and Minutes in order to give the apparatus an artistic appearance.

As to claim 76,77 : Cornelio discloses a downward curving of the head (fig 2).

As to claim 78: Cornelio discloses a frontside located within a half of the length (fig 2).

As to claim 79: Cornelio discloses a backside curving upward (fig 2).

As to claim 80: Cornelio discloses a front side curving downward (fig 2).

As to claim 81: Cornelio discloses an offset portion adjacent said base (fig 2, 44).

#### ***Allowable Subject Matter***

Claims 63-67 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 70-74 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Reissue Applications***

4. Applicant is reminded of the continuing obligation under 37 CFR 1.56 to timely apprise the Office of any litigation information, or other prior or concurrent proceeding, involving Patent No. 5,568,925 , which is material to patentability of the claims under consideration in this reissue application. This obligation rests with each individual associated with the filing and prosecution of this application for reissue. See MPEP §§ 1404, 1442.01 and 1442.04.

***Response to Arguments***

5. Applicant's arguments with respect to claims 58-81 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

The prior art made of record and relied upon.


Patent Number	Date	Patent Name	Notes
3507495	4/21/70	Tucker	
5290039	3/1/94	Cornelio	
NPL	5/15/83	Meeting Minutes	1449 document

***NOTE: 1) If Applicant believes they have not received all of the cited references noted in this office action, they should call the examiner listed below within one (1) week of receiving this notice in order to obtain duplicate material and reset the time frame of this office action. If the applicant fails to request additional materials in a timely manner, the requested materials will be resent, but the applicant will have to obtain a time extension in the normal fashion.***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Chambers whose telephone number is (703) 306-5516. The examiner can normally be reached on Mon.-Fri. from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeanette E. Chapman, can be reached on (703) 308-1310. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1078.

  
JEANETTE CHAPMAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700